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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY/DOCKET NO.	CONFIRMATION NO.
09/706,664	11/04/2000	Daniel H. Illowsky	A-69991/RMA	8986

7590- 06/25/2004
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Four Embarcadero Center
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San Francisco, CA 94111

EXAMINER

HU, JINSONG

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/706,664

Applicant(s)

ILLOWSKY, DANIEL H.

Examiner

Jinsong Hu

Art Unit

2154

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 30 days TH FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-56 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-29, 51 and 53-56, drawn to a system and method for scaling a data set and transmitting the data set to a client based on the capability of the client's device, classified in class 709, subclass 246.
 - II. Claims 30-37, drawn to a system and method for scaling a procedure or data set for determining a client attributes, classified in class 709, subclass 206.
 - III. Claims 38-39 and 47-50, drawn to a system and method for scaling a received message within a client device, classified in class 709, subclass 236.
 - IV. Claims 40-46 and 52, drawn to a system and method for optimizing content sent to a client device, classified in class 709, subclass 203.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, III and IV are disclosed as different combinations which are not connected in design, operation or effect. These combinations are independent if it can be shown that (1) they are not disclosed as capable of use together, (2) they have

different modes of operation, (3) they have different functions, or (4) they have different effects. (MPEP 806.04, MPEP 808.01).

3. In the instant case, invention I is directed to a method comprises the steps of first, second and third scaling of a message. The invention II is directed to a method comprises the steps of determining language, software version etc. from the client's attributes group and determining the format of the message. The invention III is directed to a method comprises the steps of performing a procedural scaling within a client device. The invention IV is directed to a method comprises the steps of the content by composer engine and scaling the content by the hardware abstraction layer to enable playback the content on the client device.

4. These inventions are distinct for the reasons given above, and the search required for each Group is different and not co-extensive for examination purpose. For example, the searches for the four inventions would not be co-extensive because these groups would require different searches on PTO's classification class and subclass as following:

(a) the Group I search (claims 1-29, 51 and 53-56) would require use of search Class 709, subclass 246.

(b) the Group II search (claims 30-37) would require use of search Class 709, subclass 206.

(c) the Group III search (claims 38-39 and 47-50) would require use of search Class 709, subclass 236.

(d) the Group IV search (claims 40-46 and 52) would require use of search Class 709, subclass 203.

5. Attempts to reach the Mr. R. Michael Ananian (Reg. No. 35,050) on June 17, 2004 to address a possibility of restriction requirement by telephone are unsuccessful.

6. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

7. Applicant is reminded that the required for response to this requirement is 30 days, not one month.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinsong Hu whose telephone number is (703) 306 – 5932.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee, can be reached on (703) 305-8498. The fax number for Group 2100 is (703) 872-9306.

Any inquiry of a general nature or relating to the status of the application should be directed to the Group receptionist at (703) 305-3900.

Jinsong Hu

June 22, 2004



ZARNI MAUNG
PRIMARY EXAMINER